

means for rotatably connecting said roller tube to said axle.

2. (Amended) The roller of claim 1 wherein said natural sponge member comprises a flat strip of natural sponge connected to a base material, said strip being wound diagonally along the longitudinal axis of said roller tube.

### **REMARKS**

Attached is a marked-up version of the changes made by the above amendment, in a page, captioned "Version with markings to show changes made."

The claims have been amended to more clearly emphasize the inventive concept, and to further distinguish over the cited art. Applicant confirms the election of Group I, claims 1 – 3, with traverse. Claims 1-3 are therefore pending in this application.

Support for amended Claims 1 and 2 can be found in the sentence bridging pages 4 and 5 of the specification. The Examiner has objected to the abstract, as being too long and requested that the specification be checked for minor errors. The amendments to the abstract and to the specification are believed to be responsive to these objections. Attached hereto is a marked up version of the changes made to the claims, specification and abstract by the current amendment. The attached page is captioned "Version with markings to show changes made."

The rejections of the claims as either anticipated by Serwer under 35 U.S.C. § 102(b) or as obvious over Server under 35 U.S.C. § 103(a) are respectfully traversed. A key aspect of the invention is the use of natural sponge, which provides benefits over the use of artificial sponge such as the "plastic foam of the polyurethane class" referred to by Serwer (column 2, lines 9 – 10) in that they have protrusions capable of applying paint to a surface in a positive design form. Claim 1 has been amended to specify such protrusions.

The use of sponge protrusions in the present invention in the positive method for forming designs is described on page 5, line 1 of the specification. The positive and negative methods for forming designs is described in Campbell patent 5,206,979 ("the '979 patent"), referred to on page 5, line 3 of the specification. The '979 patent describes the two methods of applying a top coat: "a negative application method, whereby the top coat is selectively removed after it has been uniformly applied over the base coat, and a positive application method, whereby the top coat is selectively applied over the base coat" (column 1, lines 24 – 29 of the '979 patent). Serwer, however, does not enable either method, but clearly shows in his drawings that the artificial sheets of sponge material he uses are smooth, with no design forming protrusions.

Moreover, the concept of using natural sponge on a roller to provide the capability of applying paint in a positive design form is not only unique, but is contrary to what can be gleaned from the relevant art. See, in this regard, Martin et al patent 4,434,521, cited in the Information Disclosure Statement filed in this application and in parent application Serial No. 09/116227 (copy attached for convenience), where "tricks of the trade" of professionals are described for obtaining novelty finishes having a textured appearance (column 1, lines 35 – 61), all without the use of rollers. Note that Martin et al describes the use of sponges (among other items) that can be used for "scoring, gouging, displacing or deforming parts of the coating already applied to the substrate (column 1, lines 43 – 45), i.e., the negative application method of the '979 patent referred to above. However, when Martin et al describe dabbing the coating composition onto the substrate, i.e., the positive application method of the '979 patent, the use of a sponge of any type is glaringly absent (column 1, lines 49 – 53). Therefore, one is lead away from the use of any sponge on a roller to apply paint to a surface in a positive design form. By using natural sponge on a paint roller, with its sponge protrusions, applicant is able to apply paint to a surface in a positive design form, something not contemplated by the "tricks of the trade" described by Martin et al.

Applicant believes the claims are in condition for allowance and respectfully solicits a Notice of Allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert Berliner', written over a horizontal line.

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## **Version with markings to show changes made**

### **IN THE TITLE**

**[ROLLER CAGE FRAME AND ]ROLLER COVER**

### **IN THE SPECIFICATION**

Amend the specification as follows:

Page 1, line 10, change "Carbell" to – Campbell –

Page 1, line 25, change "of man" to – of a man –

Page 4, line 21, change "bushing 18" to – bushing –

Page 4, line 22, change "cap member 19" to – cap member –

Page 7, line 9, change "proving" to – providing –

### **IN THE ABSTRACT**

An improved specialty paint finish roller comprising a [conventional] roller handle assembly having an axle portion, a roller tube and a naturally occurring sponge material secured around the roller tube. The [roller tube] sponge material is fabricated by slicing natural sponge [in a manner] to form [essentially] flat sponge pieces[ One of the sponge pieces is then placed over a surface of a base material having an adhesive applied thereto, the sponge material thereby adhering to the], which are adhered to a base material]. The sponge/base material is then], cut lengthwise [into an adhesive and is then] and wound about the surface of the roller member], the adhesive then being allowed to dry]. The elongated tube member is then cut to predetermined sizes, the resulting roller tube being joined to the roller handle assembly. [Using a natural sponge as the paint applicator produces a natural design, each roller being unique such that a unique design is applied to an interior wall. In addition, the natural sponge material holds a relatively large amount of paint, the paint being released

easily under pressure] The finish roller has natural sponge protrusions capable of applying paint to a surface in a positive design form.

[In a second embodiment of the invention, the conventional roller cage frame is modified by forming notches in selected elongated frame rod members whereby the roller cover positioned thereover is prevented from "walking-off" the frame because of the increased resistance provided by the notches.]

#### **IN THE CLAIMS:**

Please amend Claims 1 and 2 as follows:

1.(Amended) [A] In a specialty paint finish roller[ comprising]:

[a roller handle assembly comprising a handle and a connector member connected to said handle;

an axle connected to said connector member;]

a roller tube having first and second ends, at least one end being open, and an axial cavity located between first and second [open] ends;

a natural sponge member formed on said roller tube having natural sponge protrusions capable of applying paint to a surface in a positive design form; and

means for rotatably connecting said roller tube to said axle.

2. (Amended) The roller of claim 1 wherein said natural sponge member comprises a flat strip of natural sponge connected to a base material, said strip being wound diagonally along the longitudinal axis of said roller tube.